

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ERNIE L. DEACON
and
FARIS W. McMULLIN

Appeal No. 2003-1272
Application No. 10/039,338¹

ON BRIEF

Before HAIRSTON, FRANKFORT, NASE, BAHR and MacDONALD, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection (mailed September 24, 2002) of claims 18 to 34, which are all of the claims pending in this application.

We AFFIRM and enter a new rejection pursuant to 37 CFR § 41.50(b).

¹ Filed October 29, 2001. According to the appellants, the application is a continuation of Application No. 08/149,193, filed November 8, 1993, now U.S. Patent No. 6,354,021, which in turn was a continuation of Application No. 07/872,819, filed April 24, 1992, now U.S. Patent No. 5,259,129.

BACKGROUND

The appellants' invention relates to detachable cleats or "spikes" for golf shoes which are suitable for winter play (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

In parent Application No. 08/149,193, a panel of this Board rendered a decision on March 23, 2001.² In that decision, that panel (1) affirmed the rejection of claims 119 and 132 under 35 U.S.C. § 112, first paragraph, as being based upon a specification which does not descriptively support the claimed invention; (2) reversed the rejection of claims 113 through 138 under 35 U.S.C. § 112, second paragraph, as being indefinite; (3) reversed the rejection of claim 134 under 35 U.S.C. § 102(b) as being anticipated by Jordan, Jr. (Jordan)(U.S. Patent No. 3,583,082); (4) reversed the rejection of claims 113 through 119, 121, 123 through 130, and 132 under 35 U.S.C. § 103 as being unpatentable over Jordan; (5) reversed the rejection of claims 120, 133, and 135 under 35 U.S.C. § 103 as being unpatentable over Jordan in view of Zaleski (U.S. Patent No. 2,491,596); and (6) reversed the rejection of claims 122, 131, and 136 through 138

² The panel consisted of Administrative Patent Judges Cohen, Staab and Bahr. Administrative Patent Judges Cohen and Staab have now retired from the Board.

under 35 U.S.C. § 103 as being unpatentable over Jordan in view of Studer (France 493,748) or Hyatt (U.S. Patent No. 39,575). In that decision, that panel also made the following new grounds of rejection: (1) claims 123 through 127, 132, and 133 under 35 U.S.C. § 112, first paragraph, as being based upon an underlying disclosure which lacks descriptive support for the invention now claimed; (2) claims 123 through 127, 132, and 133 under 35 U.S.C. § 112, second paragraph, as being indefinite; and (3) claim 138 under 35 U.S.C. § 102(b) as being unpatentable over Jordan.

Subsequent to the March 23, 2001 Board decision, the applicants canceled claims 119, 123 to 133 and 138 without prejudice to applicants' right to continue prosecution of these claims in a continuing application. In addition, the applicants amended claims 113 and 134. Claims 113 to 118 and 134 to 137 were then allowed by the examiner and the patent issued on March 12, 2002.

The rejections set forth in the final rejection are as follows:

(1) Claims 18 to 25 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the appellants, at the time the application was filed, had possession of the claimed invention;

- (2) Claims 18 to 25 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention;
- (3) Claims 18 to 20, 22, 26 to 30 and 34 under 35 U.S.C. § 102(b) as being anticipated by Jordan;
- (4) Claim 21 under 35 U.S.C. § 103 as being unpatentable over Jordan;
- (5) Claims 25 and 33 under 35 U.S.C. § 103 as being unpatentable over Jordan in view of Zaleski;
- (6) Claims 18 to 34 under the judicially created doctrine of double patenting over claims 1 to 13 of U.S. Patent No. 6,354,021; and
- (7) Claims 18 to 34 under the judicially created doctrine of double patenting over claims 1 to 10 of U.S. Patent No. 5,259,129.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (mailed January 31, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (filed January 14, 2003) and reply brief (filed March 31, 2003) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The double patenting rejections

We sustain the rejection of claims 18 to 34 under the judicially created doctrine of double patenting over claims 1 to 13 of U.S. Patent No. 6,354,021 and the rejection of claims 18 to 34 under the judicially created doctrine of double patenting over claims 1 to 10 of U.S. Patent No. 5,259,129.

In the final rejection (p. 6) and the answer (pp. 7-8), the examiner set forth his rationale as to why claims 18 to 34 were subject to these rejections under the judicially created doctrine of double patenting.

The appellants have not specifically contested these rejections in the brief or reply brief.³ Accordingly, we summarily sustain both rejections of claims 18 to 34 under the judicially created doctrine of double patenting.

The indefiniteness rejection

We will not sustain the rejection of claims 18 to 25 under 35 U.S.C. § 112, second paragraph.

The basis for this rejection (answer, p. 4) is as follows:

the phrase "traction means" is vague and indefinite. The disclosed ribs are readily found to be the corresponding structure described in the specification (sixth paragraph of 35 U.S.C. 112) but the "equivalents" of the ribs in this art, as ribs are defined by appellants, are not characterized. For this reason, the metes and bounds of the claims are uncertain or indefinite.

As explained in In re Donaldson, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848-49 (Fed. Cir. 1994), the USPTO is not exempt from following the statutory mandate of 35 U.S.C. § 112, paragraph 6, which reads:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or

³ The discussion of these rejections on page 16 of the brief does not constitute an argument pointing out any error in the rejections. Instead, the discussion points out the error in the examiner rejections under 35 U.S.C. § 112.

acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

The court's holding in Donaldson does not conflict with the principle that claims are to be given their "broadest reasonable interpretation" during prosecution. See, e.g., In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). Generally speaking, this claim interpretation principle remains intact. Rather, the holding in Donaldson merely sets a limit on how broadly the USPTO may construe means-plus-function language under the rubric of "reasonable interpretation." Per Donaldson, the "broadest reasonable interpretation" that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the USPTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination. Donaldson similarly does not conflict with the second paragraph of section 112. Indeed, the court in Donaldson agreed with the general principle espoused in In re Lundberg, 244 F.2d 543, 547-48, 113 USPQ 530, 534 (CCPA 1957), that the sixth paragraph of section 112 does not exempt an applicant from the requirements of the first two paragraphs of that section. Although paragraph six statutorily provides that one may use means-plus-function language in a claim, one is still subject to the requirement that a claim "particularly point out and distinctly claim" the invention.

Therefore, if one employs means-plus-function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112. Also, Donaldson does not conflict with the general claim construction principle that limitations found only in the specification of a patent or patent application should not be imported or read into a claim. See In re Priest, 582 F.2d 33, 37, 199 USPQ 11, 15 (CCPA 1978). One must be careful not to confuse impermissible imputing of limitations from the specification into a claim with the proper reference to the specification to determine the meaning of a particular word or phrase recited in a claim. See E.I. Du Pont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 1433, 7 USPQ2d 1129, 1131 (Fed. Cir. 1988).

Thus, claims written in means-plus-function format for which no structure has been identified gives rise to claims which are not technically sufficient to provide appropriate notice to a person of ordinary skill in the art of the identity of the exact structure required, and therefore, the scope of the claim. The test for definiteness in such instances is whether "structure supporting a means-plus-function claim under §112, ¶ 6 [appears] in the specification," Atmel Corp. v. Information Storage Devices, Inc., 198 F.3d 1374, 1381, 53 USPQ2d 1225, 1229 (Fed. Cir. 1999) (emphasis added).

Thus, in order for a claim to meet the particularity requirement of 35 U.S.C. § 112, ¶ 2, "the corresponding structure(s) of a means-plus-function limitation must be disclosed in the written description in such a manner that one skilled in the art will know and understand what structure corresponds to the means limitation. Otherwise, one does not know what the claim means. Id. 198 F.3d at 1382, 53 USPQ2d at 1230.

In this case, only one embodiment of "traction means" is described in the written description.⁴ As set forth on page 6 of the specification:

A plurality of traction ribs 15 are formed on the bottom traction surface of generally concavo-convex flange 12. While the ribs 15 may be present in a variety of configurations, preferably they are arranged in a radial fashion emanating from near the center of concavo-convex flange 12. The cross sectional shape of ribs 15 may be arcuate, triangular (FIG. 8), rectangular or a combination thereof. Preferably, ribs 15 are triangular, but with rounded edges to provide the best compromise between traction and damage to the turf. By "rounded edges" we mean that whenever two surfaces meet (the edge), the region of the edge is free from sharp points or angularity (rounded). This is true wherever our cleat may meet the turf -- on the ribs 15 and on the bottom surface of the flange.

The paragraph bridging pages 7-8 of the specification provides:

By "ribs" we mean more than one vertical ridges in the bottom surface of flange 12. The ridges have a crest that is at least one line, compared to the crest of the prior art spikes which are a point or a circle (for a truncated cone, for example). Preferably, the ridges are about as wide at their base as they are high. The ridges may be straight or curved in planes parallel to the shoe sole, and they

⁴ The written description includes the drawings and the abstract. See Playtex Products Inc. v. Procter & Gamble Co., 400 F.3d 901, 909, 73 USPQ2d 2010, 2016 (Fed Cir. 2005).

may be chords, diameters, or radii of the bottom surface of the disklike flange 12. Preferably, the ridges are between about 0.03125" and 0.125" high. Preferably, the flange's bottom surface has 8 crescent shaped ridges.

The phrase "traction means" encompasses the corresponding structure described in the specification⁵, i.e., the traction ribs, and equivalents thereof. In our view, the meaning of "equivalents" is well understood in patent law and an applicant need not, and in fact can not, describe in his specification the full range of equivalents of his invention, some of which may be nonexistent at the time the application is filed.⁶ See In re Noll, 545 F.2d 141, 149, 191 USPQ 721, 727 (CCPA 1976), cert. denied, 434 U.S. 875 (1977).

Since structure supporting the claimed "traction means" is set forth in the written description, the rejection under 35 U.S.C. § 112, second paragraph, is not appropriate.

⁵ More properly, the written description of the application. See Hester Indus., Inc. v. Stein, Inc., 142 F.3d 1472, 1483, 46 USPQ2d 1641, 1650 (Fed. Cir. 1998); Dawn Equip. Co. v. Ky. Farms Inc., 140 F.3d 1009, 1014, 46 USPQ2d 1109, 1112 (Fed. Cir. 1998).

⁶ We agree with the appellants that equivalents under the sixth paragraph of 35 U.S.C. § 112 are, by definition, never disclosed in the application. While an application may disclose one preferred embodiment to perform a function as well as numerous equivalent ways of performing that function, under 35 U.S.C. § 112, sixth paragraph, the corresponding structure includes both the one preferred embodiment to perform a function and the numerous equivalent ways of performing that function. Thus, equivalents under the sixth paragraph of 35 U.S.C. § 112 to a means for performing that function includes both equivalents of the one preferred embodiment that performs the function and equivalents of the numerous disclosed equivalent ways of performing the function.

Accordingly, the decision of the examiner to reject claims 18 to 25 under 35 U.S.C. § 112, second paragraph, is reversed.

The written description rejection

We will not sustain the rejection of claims 18 to 25 under 35 U.S.C. § 112, first paragraph.

The basis for this rejection (answer, pp. 3-4) is as follows:

the phrase "traction means" is considered to be new matter because it was introduced into the application subsequent to the filing of the application.⁷ A means plus function recitation is construed to cover the corresponding structure, material or acts described in a specification and equivalents thereof. Addressing the particular facts of the present case, appellants only disclosed "ribs", with no mention whatsoever of any alternatives or equivalents thereof at the time of the filing of the application. Thus, one skilled in the art, reading the original disclosure, would not have been informed of appellants' interest in or possession of equivalents, now claimed as part of the means plus function recitation. In this case by introducing a means plus function recitation into the present application, subsequent to its filing date (the filing date of the original parent application), appellants have, in effect, added to the original disclosure equivalents of the ribs. Thus, this late introduction of a means plus function recitation adds new matter (equivalents) to the application since the means plus function recitation lacks a descriptive basis as to the inclusion of any equivalents in the original disclosure.

⁷ Claims 18 to 34 were added by the preliminary amendment filed with the application on October 29, 2001.

In our view, claims 18 to 25 which include the phrase "traction means" do not violate the written description requirement set forth in the first paragraph of 35 U.S.C. § 112. The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). In this case, it is clear that the appellants had possession of the claimed "traction means" in the form of the corresponding structure described in the specification (i.e., the traction ribs). As to the equivalents that are by statute encompassed by the claimed "traction means," we agree with the appellants that such equivalents are, by definition, never disclosed in the application. As such, it is our determination that the written description requirement is not violated by claims 18 to 25.⁸

For the reasons set forth above, the decision of the examiner to reject claims 18 to 25 under 35 U.S.C. § 112, first paragraph, is reversed.

⁸ We note that the examiner did not reject claims 26 to 34 under this basis even though these claims broaden the disclosed traction ribs to protrusions, traction members, or traction elements. However, we have entered a new ground of rejection pursuant to 37 CFR § 41.50(b) in this decision.

The anticipation rejection

We will not sustain the rejection of claims 18 to 20, 22, 26 to 30 and 34 under 35 U.S.C. § 102(b).

Jordan discloses a track shoe cleat (Figures 1-4) for use on composition tracks or other modern surfaces formed of natural or synthetic materials such as synthetic turf (column 1, lines 44-47 and column 2, lines 1-4). The cleat is characterized by a circular disc 16 having a plurality of bristles 18 extending down from the bottom surface thereof. The bristles are of tough plastic, for example, nylon or polycarbonate varieties (column 2, lines 29-31). As explained by the patentee (column 2, lines 51-53), "the bristle spikes are most effective when they result in indentation of a running surface as opposed to penetration of the surface." As set forth in each of claims 3 and 9 thereof, the bristles extend from the bottom surface of the body portion (disc 16) for a distance of between "about 1/16 inch to 1/4 inch."

Jordan's track shoe cleat seeks to overcome a damage problem that accrues from the use of long and sharp metal traction spikes that penetrate a track surface (column 1, lines 21-40). Jordan teaches (column 2, lines 25-27) that the bristles have sufficient stiffness so that they won't collapse or break when supporting the weight of an athlete. Jordan sets a lower limit of about 10 bristles per square inch and an upper limit

of 40 bristles per square inch (column 2, lines 34-42). At the lower limit of about 10 bristles per square inch Jordan provides that the bristles will be formed of a material with a "high stiffness."

The examiner's basis for this anticipation rejection (answer, p. 5) is as follows:

Considering the disclosed density of about 10 bristles per inch it is clear that one skilled in the art would understand that the underside of the circular disc (flange) would be exposed between bristles and would also be capable of distributing weight over turf being walked on, while the bristles additionally support weight and provide traction. Based upon the overall Jordan, Jr. teachings, it is quite apparent that one skilled in this art would have fairly expected the bristles (protrusions) of Jordan, Jr. to provide traction without doing damage to the turf surface being walked on and without puncturing turf.

The appellants argue that claims 18 to 20, 22, 26 to 30 and 34 are not anticipated⁹ since Jordan does not disclose a cleat which provides traction against the ground without doing damage to the turf surface being walked on and without puncturing golf turf. We agree.

⁹ Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

It is well-settled that under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). As the court stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)(quoting Hansgirg v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. [Citations omitted.] If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

In this case, the examiner's determination that "one skilled in this art would have fairly expected the bristles (protrusions) of Jordan, Jr. to provide traction without doing damage to the turf surface being walked on and without puncturing turf" is based on shear speculation and is not the natural result flowing from the teachings of Jordan. In that regard, it is our opinion that the cleat with bristles as taught by Jordan is more akin to the prior art spikes which are formed of a strong stiff material and provide a point or a circle (for a truncated cone, for example) contact with the turf and thus damage and penetrate golf turf than to the appellants' cleat of resilient material with ribs/ridges which

provide a series of line contacts with the turf and thus prevent damage to the turf and do not penetrate golf turf.

For the reasons set forth above, claims 18 to 20, 22, 26 to 30 and 34 are not anticipated by Jordan. Accordingly, the decision of the examiner to reject claims 18 to 20, 22, 26 to 30 and 34 under 35 U.S.C. § 102(b) is reversed.

The obviousness rejections

We will not sustain the examiner's rejections of claims 21, 25 and 33 under 35 U.S.C. § 103. We have reviewed the patent to Zaleski additionally applied in the rejection of claims 25 and 33 but find nothing therein which makes up for the deficiency of Jordan discussed above.

New ground of rejection

Under the provisions of 37 CFR § 41.50(b), we enter the following new ground of rejection.

Claims 26 to 34 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as

to reasonably convey to one skilled in the relevant art that the appellants, at the time the application was filed, had possession of the claimed invention.

Claims 26 to 34 were added to this application via a preliminary amendment filed October 29, 2001. The preliminary amendment does not enjoy status as part of the original disclosure since the executed declaration does not reference the preliminary amendment. See MPEP §608.04(b). We, therefore, view these claims as distinct from the original disclosure and subject to a written description rejection.

Claim 26 is drawn to a removable golf shoe cleat comprising, inter alia, a flange, attachment means and a plurality of protrusions that provide traction against the ground without doing damage to the turf surface being walked on and without puncturing golf turf. Claims 27 to 33 are drawn to a removable golf shoe cleat comprising, inter alia, a flange, attachment means and a plurality of traction members that provide traction against the turf wherein the cleat provides traction against the ground without doing damage to the turf surface being walked on and without puncturing golf turf. Claim 34 is drawn to a removable golf shoe cleat comprising, inter alia, a flange, attachment means and a plurality of traction elements that provide traction on the turf wherein the traction is provided without doing damage to the turf and without puncturing golf turf.

We question whether the appellants' disclosure, as filed, reasonably conveys to a person skilled in the art that the inventor had possession of the subject matter broadly recited in claims 26 to 34. The Federal Circuit has continued to apply the general rule that disclosure of a species may be sufficient written description support for a later claimed genus including that species. See Bilstad v. Wakalopulos, 386 F.3d 1116, 1124-25, 72 USPQ2d 1785, 1791 (Fed. Cir. 2004). However, exceptions to the general rule that disclosure of a species provides sufficient written description support for a later filed claim directed to the genus do exist. See In re Curtis, 354 F.3d 1347, 69 USPQ2d 1274 (Fed. Cir. 2004); Tronzo v. Biomet, Inc., 156 F.3d 1154, 47 USPQ2d 1829 (Fed. Cir. 1998); and Gentry Gallery, Inc. v. Berkline Corp., 134 F.3d 1473, 45 USPQ2d 1498 (Fed. Cir. 1998).

In our view, the appellants' written description, as filed, would not reasonably convey to a person skilled in the art that the appellants had possession of the subject matter of claims 26 to 34. We reach this conclusion based on the specific teachings of the original application. On pages 2-3 of the specification, the appellants teach that:

During the winter months, some greens keepers of golf courses prohibit the use of standard metal golf shoe spikes because of their detrimental effect on the fairways and greens of the golf course. . . .

Many avid golfers continue golfing regularly through-out the winter months, even though they cannot use spikes. Until the instant invention, the only alternative for winter golfers who usually wear spikes has been to wear tennis

shoes which do not damage the golf course. Besides the problem of not providing sufficient traction to the golfer, this tennis shoes approach requires an additional investment by the golfer in a second pair of shoes.

What is needed is a replaceable cleat or spike for use in place of a standard metal spike for a golf shoe which does not cause damage to the golf course, especially in inclement or cold weather. Accordingly, one of the objects of the instant invention is to provide a spike which satisfies this need.

The specification then provides (pp. 3-4) that:

This object, along with others, is accomplished by a replaceable cleat formed of a thermoplastic or similar material. The cleat has a plurality of ribs on the traction surface in place of standard pointed protuberances. The cleat is formed generally in a unitary body having a threaded stud axially protruding from the upper surface of a generally concavo-convex flange from the perspective of sole 2. The ribs may be present in a variety of configurations, and may be formed with an arcuate, triangular or rectangular cross section.

These teachings, taken with the parts of the specification quoted above in our discussion of the indefiniteness rejection, make it clear to us that the original application discloses only traction ribs/ridges and nothing broader. In order for a disclosure to be inherent the missing descriptive matter must necessarily be present in the specification such that one skilled in the art would recognize such a disclosure. We find that there is nothing in the appellants' specification to suggest that shapes other than ribs/ridges that each provide a line contact with the turf and thus prevent damage to the turf and do not penetrate golf turf are necessarily a part of the disclosure. Indeed, as discussed above, the specification clearly teaches that protrusions which provide a point or a circle (for a

truncated cone, for example) contact with the turf damage and penetrate golf turf. As such, one skilled in the art would have understood from the appellants' original disclosure that only a cleat having ribs/ridges which provide a series of line contacts with the turf would be able to prevent damage to the turf and would not penetrate golf turf. Thus, in light of the foregoing, the level of predictability in this field would have been such that one skilled in the art would have been surprised to discover that protrusions, traction members or traction elements other than ribs providing a line contact (e.g., protrusions that provide a point or circle contact) could be designed in a manner so that the protrusions do not damage the turf and would not penetrate golf turf.

For the reasons set forth above, the original disclosure does not support the later-claimed, generic subject matter of claims 26 to 34.

CONCLUSION

To summarize, the decision of the examiner to reject claims 18 to 34 under the judicially created doctrine of double patenting over claims 1 to 13 of U.S. Patent No. 6,354,021 is affirmed; the decision of the examiner to reject claims 18 to 34 under the judicially created doctrine of double patenting over claims 1 to 10 of U.S. Patent No. 5,259,129 is affirmed; the decision of the examiner to reject claims 18 to 25 under

35 U.S.C. § 112, first paragraph, is reversed; the decision of the examiner to reject claims 18 to 25 under 35 U.S.C. § 112, second paragraph, is reversed; the decision of the examiner to reject claims 18 to 20, 22, 26 to 30 and 34 under 35 U.S.C. § 102(b) is reversed; the decision of the examiner to reject claim 21 under 35 U.S.C. § 103 is reversed; and the decision of the examiner to reject claims 25 and 33 under 35 U.S.C. § 103 is reversed. In addition, a new rejection of claims 26 to 34 under 35 U.S.C. § 112, first paragraph, has been added pursuant to provisions of 37 CFR § 41.50(b).

Since at least one rejection of each of the appealed claims has been affirmed, the decision of the examiner is affirmed.

Regarding the affirmed rejections, 37 CFR § 41.52(a)(1) provides "[a]ppellant may file a single request for rehearing within two months from the date of the original decision of the Board."

In addition to affirming at least one of the examiner's rejections of claims 18 to 34, this decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .
- (2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should the appellants elect to prosecute further before the examiner pursuant to 37 CFR § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejections, the effective date of the affirmation is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejections are overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejections, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED; 37 CFR § 41.50(b)

CHARLES E. FRANKFORT
Administrative Patent Judge

Allen R. MacDonald)
ALLEN R. MacDONALD)
Administrative Patent Judge)

BAHR, Administrative Patent Judge, concurring.

I join in the majority decision with respect to rejections (6) and (7), as well as the new ground of rejection of claims 26 to 34, and I concur in the result reached with respect to rejections (1) and (2). I also concur in the majority's ultimate decision to reverse rejections (3), (4) and (5), the prior art rejections, but, as explained more fully below, my reasons for this decision differ somewhat from those of the majority. Moreover, for the reasons which follow, I have concerns about the scope of the "traction means" clause in claims 18 to 22 and 25 and question whether appellants' specification as originally filed provides support for such scope, as required under the first paragraph of 35 U.S.C. § 112.

Turning first to the prior art rejections, while I might agree with the majority that the cleat with bristles as taught by Jordan is more akin to cleats with spikes which provide a point or circle contact with the turf, I am also cognizant of the unabridged video showing alluded to on page 28 (footnote 18) of the March 23, 2001 Board decision in parent Application No. 08/149,193, of not only a cleat with swirl or curved ribs but also a cleat with mini-spikes (generally circular protrusions) being used for traction without doing damage to the turf surface being walked on and without puncturing the golf turf. Accordingly, any similarity between Jordan's cleat and cleats

provided with a plurality of circle or even point contacts does not, in and of itself, provide any indication that the Jordan bristles will puncture golf turf or do damage to the turf surface being walked on, as the majority seems to imply.

It cannot be disputed that anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. See RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

It is certainly also true that, in order to establish a case of anticipation under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present

in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. See Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). We must not lose sight, however, of the fact that, once the USPTO establishes a *prima facie* case of anticipation based on inherency, the burden shifts to appellants to "prove that the subject matter shown to be in the prior art does not possess the characteristic relied on." See In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986).¹

While it can certainly be debated whether the examiner came forth with enough explanation to establish a *prima facie* case that the bristles of Jordan will provide traction against the ground without doing damage to the turf surface being walked on and without puncturing golf turf, I believe that such a case can be made, so as to shift the burden to appellants to prove otherwise. First, Jordan expressly teaches that "[i]n use, the bristle spikes are most effective when they result in indentation of the running surface as opposed to penetration of the surface" (column 2, lines 61-63). While Jordan does not particularly enumerate "golf turf" as one of the surfaces for which the cleats are specifically designed for use, Jordan does mention "modern track surfaces which may be formed of composition materials, synthetic turf, or other variations of

¹ The rationale for this burden-shifting is the recognition that the USPTO is not equipped to perform the experimentation necessary to produce such proof. Id.

natural and synthetic materials" (column 2, lines 2-4), which will exhibit a wide range of resilience and hardness properties. In this regard, it is critical to note that the hardness and resilience properties of natural turf vary over a huge range, depending on the condition of the soil, the condition of the plant, the time of year, amount of recent rainfall, etc.² Against this background, Jordan's description of the bristle spikes as resulting in indentation as opposed to penetration of the surface is, in my opinion, strong evidence that, at least for some types of golf turf under certain conditions, the bristle spikes will provide traction without damaging or puncturing the turf.

Moreover, there are many similarities between appellants' traction ribs and Jordan's bristles. For example, Jordan discloses bristles extending a distance between about 1/16 inch and 1/4 inch (claims 3 and 9), a substantial portion of which range falls within the range of 1/32 inch and 1/8 inch disclosed by appellants on page 8 of their specification. Further, Jordan discloses bristle diameters between 1/64 inch and 1/8 inch, a substantial portion of which range falls within the range of base widths (1/32 inch

² The recitations "without doing damage to the turf surface" and "without puncturing the golf turf" are not so limiting, in my opinion, as to require that the cleats avoid damage to and puncture of every conceivable type of golf turf under every conceivable condition. In fact, appellants' cleats most certainly could not meet such a stringent standard. A cleat meets these limitations if there is any golf turf which would not be damaged or punctured when walked on by a person wearing a shoe having such a cleat attached thereto.

to 1/8 inch) disclosed by appellants on page 8 of their specification.³ Further, taking as an example, Jordan's lower end of 10 bristles per square inch and a bristle diameter of 1/8 inch, the contact surface area presented by the bristles would be just slightly less than 1/8 in.² per square inch of the cleat body (or approximately 1/8 of the surface area of the cleat body), which would appear to either approach or exceed that presented by the traction ribs of appellants' cleats, as illustrated in Figures 2 and 3, for example.

I am also writing separately because I am concerned that the problems discussed by the majority in the new ground of rejection of claims 26 to 34 under the first paragraph of 35 U.S.C. § 112 also spill over into claims 18 to 22 and 25, which recite "traction means extending from the opposing bottom surface of said flange." I agree with the majority that the written description of appellants' application as originally filed would have conveyed to one of ordinary skill in the art that only ribs/ridges, defined on page 7 of appellants' specification as having "a crest which is at least one line, compared to the crest of the prior art spikes which are a point or a circle (for a truncated cone, for example)," would be capable of providing traction without damaging the turf or penetrating golf turf in the manner contemplated by appellants' application. Stated differently, protrusions which do not have a crest which is at least one line (i.e., which

³ I note, in this regard, that the effective contact width of appellants' triangular ribs will be significantly less than the width at the base of the rib.

are not ribs) would not be considered to fall within the scope of appellants' invention as presented in the application as originally filed.

The "traction means" limitation of claims 18 to 22 and 25⁴ is a means-plus-function limitation and must be construed, in accordance with 35 U.S.C. § 112, sixth paragraph, to cover the corresponding structure described in the specification and equivalents thereof. In light of the above, it is apparent to me that the corresponding structure for the "traction means" described in appellants' specification is ribs/ridges and only ribs/ridges. It is equally apparent to me that the original written description expressly excluded from the scope of the invention protrusions that are not ribs/ridges, that is, protrusions not having a crest that is at least one line. Consequently, for the reasons articulated on pages 17 through 20 of the majority's decision, appellants' application as originally filed fails to provide written description support, as required in 35 U.S.C. § 112, first paragraph, for any type of protrusion which would not meet appellants' definition of rib or ridge.

⁴ Claims 23 and 24 further recited that the traction means comprise ribs and thus are not construed under 35 U.S.C. § 112, sixth paragraph. The use of the term "means" does not invoke 35 U.S.C. § 112, sixth paragraph, when it is modified by structure for performing the function. See Rodime PLC v. Seagate Technology, Inc., 174 F.3d 1294, 1303-04, 50 USPQ2d 1429, 1435-36 (Fed. Cir. 1999).

The scope of the "traction means" limitation, however, is not limited to simply the corresponding structure in appellants' specification but, rather, would also include equivalents of ribs/ridges in accordance with 35 U.S.C. § 112, sixth paragraph. While teachings in appellants' specification are one factor in determining whether particular structure is an equivalent, the inquiry into what is considered to be an "equivalent" under 35 U.S.C. § 112, sixth paragraph, does not end with the written description portion of the specification and, indeed, does not end with the specification itself. Our reviewing court has set forth a test for equivalents under 35 U.S.C. § 112, sixth paragraph, as follows:

In order for an accused structure to literally meet a section 112, paragraph 6 means-plus-function limitation, the accused structure must either be the same as the disclosed structure or be a section 112, paragraph 6 "equivalent," i.e., (1) perform the identical function and (2) be otherwise insubstantially different with respect to structure. Under a modified version of the function-way-result methodology described in Graver Tank & Manufacturing Co. v. Linde Air Products Co., 339 U.S. 605, 608, 70 S.Ct. 854, 94 L.Ed. 1097, 85 USPQ 328, 330 (1950), two structures may be "equivalent" for purposes of section 112, paragraph 6 if they perform the identical function, in substantially the same way, with substantially the same result. If an accused structure is not a section 112, paragraph 6 equivalent of the disclosed structure because it does not perform the identical function of that disclosed structure and hence does not literally infringe, it may nevertheless still be an "equivalent" under the doctrine of equivalents. Thus, if one applies the traditional function-way-result test, the accused structure must perform substantially the same function, in substantially the same way, to achieve substantially the

same result, as the disclosed structure. A key feature that distinguishes "equivalents" under section 112, paragraph 6 and "equivalents" under the doctrine of equivalents is that section 112, paragraph 6 equivalents must perform the identical function of the disclosed structure, while equivalents under the doctrine of equivalents need only perform a substantially similar function [citations omitted].

Kemco Sales, Inc. v. Control Papers Co., 208 F.3d 1352, 1364, 54 USPQ2d 1308, 1315-16 (Fed. Cir. 2000). I note, in this regard, that the recited function in the "traction means" limitation of claims 18 to 22 and 25 is simply "traction" or "providing traction" and does not require either line contact or traction without doing damage to the turf or puncturing golf turf. Accordingly, even the prior art spikes which are a point or a circle, mentioned on page 7 of appellants' specification and expressly distinguished from the ribs/ridges of appellants' invention, and the mini-spikes in the video showing mentioned *supra* appear to perform the recited function of providing traction, in substantially the same way, to achieve substantially the same result, as the disclosed ribs/ridges. They would thus appear to be "equivalents" of the traction ribs described in appellants' specification under 35 U.S.C. § 112, sixth paragraph, under the test announced by Kemco, thereby falling within the scope of the "traction means" limitation of claims 18 to 22 and 25, but are not supported by appellants' original specification as required by 35 U.S.C. § 112, first paragraph. Further, the presentation of broad recitations, such as "protrusions," "traction members" and "traction elements" in claims 26, 27 and 34 would also point to a broader scope to "traction means" than simply ribs/ridges as defined in

appellants' specification. Of course, on the other hand, appellants' express exclusion in the specification of any protrusions other than ribs/ridges for providing traction would, it seems to me, be one factor against considering point or circle protrusions as being equivalents under 35 U.S.C. § 112, sixth paragraph.

For all of the above reasons, the presentation of claims reciting "traction means," a means-plus-function with such a broad functional recitation, for the first time after the original filing of the application, which contained such a restrictive teaching with respect to the structure for providing traction, does not strike me as being in compliance with the written requirement of 35 U.S.C. § 112, first paragraph, or consistent with the spirit of the sixth paragraph of that section. Thus, while I agree with the majority that the rejections under 35 U.S.C. § 112 as articulated by the examiner should not be sustained, I question whether claims 18 to 22 and 25 lack written description support in violation of the first paragraph of 35 U.S.C. § 112.


JENNIFER D. BAHR
Administrative Patent Judge

) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES

HAIRSTON, Administrative Patent Judge, concurring-in-part and dissenting-in-part.

With respect to the rejections of record, I agree with all of the actions taken by the majority. I do not, however, agree with the majority or the concurring opinion by Judge Bahr that claims 26 through 34 should be rejected for lack of written description.

Nothing in the prior art of record precludes appellants from broadly claiming their invention as "protrusions" (claim 26), "traction members" (claims 27 through 33) or "traction elements" (claim 34) that provide traction without damaging or puncturing golf turf. If there is prior art directed to such spikes, it certainly has not been made of record for our consideration. The majority opinion and Judge Bahr's opinion to the contrary notwithstanding, nothing in the originally filed disclosure precludes appellants from using such broad terms to describe their invention.

In the paragraph bridging pages 3 and 4 of the specification, appellants clearly explain that:

The cleat has a plurality of ribs on the traction surface in place of standard pointed protuberances¹. The cleat is formed generally in a unitary body having a threaded stud axially protruding from the upper surface of a generally concavo-convex flange from the perspective of sole 2. The ribs may be present

¹ A protuberance is defined as something that protrudes.

in a variety of configurations, and may be formed with an arcuate, triangular or rectangular cross section. (Emphasis added).

On page 5 of the specification, appellants state that "the cleat maintains its resiliency for traction." (Emphasis added). On page 6 of the specification, appellants explain that "[a] plurality of traction ribs 15 are formed on the bottom traction surface of generally concavo-convex flange 12." (Emphasis added). On this same page of the specification, appellants state that "[p]referably, ribs 15 are triangular, but with rounded edges to provide the best compromise between traction and damage to the turf." (Emphasis added). The Abstract of the disclosure states that "traction ribs 15 are formed on the bottom traction surface of concavo-convex flange 12." (Emphasis added).

In short, the quoted excerpts from appellants' specification provide more than ample written description for "protrusions," "traction members" and "traction elements" on a golf spike that do not damage or puncture golf turf. Stated differently, the disclosed traction ribs 15 are "protrusions" from the flange, and they function as either "traction members" or "traction elements."

The majority's and Judge Bahr's concern over what other shapes besides ribs/ridges will perform the same function of the traction ribs is not our concern in an ex

parte examination of appellants' disclosed and claimed invention for written description support. Such an inquiry will most certainly be made if any patent containing this invention is involved in an inter partes infringement proceeding. In such an inter partes proceeding, the Court may find, as Judge Bahr² would find, that "the corresponding structure for the 'traction means' described in appellants' specification is ribs/ridges and only ribs/ridges." Until that day, however, appellants are entitled to claim the ribs/ridges as set forth in the claims on appeal.



KENNETH W. HAIRSTON
Administrative Patent Judge

) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES

² I agree with Judge Bahr's statement that "[t]he 'traction means' limitation of claims 18 to 22 and 25 is a means-plus-function limitation and must be construed, in accordance with 35 U.S.C. § 112, sixth paragraph, to cover the corresponding structure described in the specification and equivalents thereof."

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